

- Group VI: Claims 30 and 34, drawn to a process of preparing a dough using the xylanase;
- Group VII: Claim 31, drawn to a method of identifying a bacterial xylanase or mutant thereof suitable for making baked product;
- Group VIII: Claim 36, drawn to a method of identifying a xylanase composition or a medium in which a xylanase is to be prepared or a medium to which a xylanase is to be added;
- Group IX: Claim 38, drawn to a process of preparing an identified composition;
- Group X: Claim 39, drawn to a method of preparing a dough using an identified composition; and
- Group XI: Claim 41, drawn to a method of determining the amount of inhibitor and xylanase to be added to a wheat flour.

In response to the Restriction Requirement, Applicant hereby elects Group III, claim 21, drawn to an inhibitor of endo-xylanase, for prosecution in the subject application, **with traverse**.

Applicant traverses on the grounds that: (1) at least claims 21, 26-30, and 41 should be in the same Group; (2) at least claims 1-8 and 11 should be in the same group; and (3) the search and examination of claims 21, 26-30, and 41, or claims 1-8 and 11, is not undue or burdensome.

A. Grouping of Claims 21, 26-30, and 41

According to the Examiner, claims 21, 26-30, and 41 are classified into seven (7) Groups of claims: Group I (claims 1-8 and 27), Group II (claims 11, 28, and 32), Group III (claim 21), Group IV (claim 26), Group V (claims 29 and 33), Group VI (claims 30 and 34), and Group XI (claim 41). At least claims 21, 26-30, and 41 should be classified together for at least the following reasons:

- (1) claim 21 refers to specific xylanase inhibitors and claim 26 refers to using one or more of these inhibitors to screen for xylanases with a specific degree of resistance;

- (2) Claim 27 recites xylanases identified using the screening method of claim 26;
- (3) Claim 28 recites a foodstuff comprising a xylanase identified using the screening method of claim 26;
- (4) Claims 29 and 30 both carry out the method of claim 26 (*see* step (a)), but then include a further two steps of identifying xylanases with a specific degree of resistance, and either preparing a quantity of these xylanases or preparing a dough comprising these xylanases; and
- (5) Claim 41 is dependent upon the inhibitors of claim 21.

Each of claims 21, 26-30, and 41 are linked by a common inventive concept, namely the specific xylanase inhibitors and/or use thereof to identify xylanases having a specific degree of resistance thereto. Accordingly, Applicant respectfully requests that the Examiner include claims 26-30 and 41 in the examination of elected Group III, claim 21.

B. Grouping of Claims 1-8 and 11

According to the Examiner, claims 1-8 and 11 are classified into two (2) Groups of claims: Group I (claims 1-8 and 27) and Group II (claims 11, 28, and 32). At least claims 1-8 and 11 should be classified together as claim 11 simply refers to a foodstuff comprising the enzyme according to claim 1.

C. Burden of search

It is respectfully submitted that the subject matter of at least claims 21, 26-30, and 41, and the subject matter of claims 1-8 and 11, are sufficiently related that a thorough search of the subject matter of any one single independent claim would necessarily encompass a search for the subject matter of the remaining claims.

Thus, it is respectfully submitted that the search and examination of at least claims 21, 26-30, or claims 1-8 and 11, could be performed without serious burden. MPEP §803 clearly states that "If the search and examination of [multiple claims] can

be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." (emphasis added). It is respectfully submitted that this policy should apply in the present application to avoid unnecessary delay and expense to Applicant in duplicative examination by the Patent Office.

II. Concluding Remarks

The Examiner is respectfully requested to re-Group the claims as detailed above.

In accordance with this election with traverse, Applicant reserves all rights in the non-elected claims, including the right to file one or more divisional applications covering the subject matter thereof.

If there are any fees due in connection with the filing of this Response, please charge the fees to Deposit Account No. 19-0741. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 CFR §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Atty. Dkt. No. 078883-0132

Appln. No.: 09/869,155

Respectfully submitted,

Date May 9, 2003

FOLEY & LARDNER

Customer Number: 22428



22428

PATENT TRADEMARK OFFICE

Telephone: (202) 672-5538

Facsimile: (202) 672-5399

By Michele M. Simkin

Michele M. Simkin

Attorney for Applicant

Registration No. 34,717